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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,335	07/05/2002	Phoebe Harriet Johnson	60662-300101	2456

7590

08/26/2004

Perkins Coie  
101 Jefferson Drive  
Menlo Park, CA 94025-1114

EXAMINER
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NGUYEN, CINDY

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/070,335	<b>Applicant(s)</b> JOHNSON ET AL.	
	<b>Examiner</b> Cindy Nguyen	<b>Art Unit</b> 2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2002.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

This is in response to application filed on 07/05/02 in which claims 1-30 are presented for examination.

#### **1. *Priority(IDS)***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Claim Objections***

Claims 8 and 22 are objected to because of the following informalities: claim 8, line 2 and claim 22, lines 1, the “notifying” is misspelled. Appropriate correction is required.

#### **2. *Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**3. Claims 1 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Listou (U.S 6216139).**

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Regarding claims 1 and 15, Listou discloses: an information management system and method able to assist with the management and monitoring of a multiplicity of documents containing rights and/or obligations including due dates, arising out of a plurality of primary documents, the system including: a database adapted to store in an electronic and searchable format the plurality of primary documents (project A-C) ( fig. 4 and col. 9, lines 36-54, Listou);

an electronic diary system which records at least selected due dates (Date due) arising out of the primary documents (projects A-C) (fig. 4-6, Listou) and which is electronically linked (508, fig. 5, Listou) to the database such that a user is able to access the primary documents to which the due dates pertain directly via said electronic link (user scroll through all text data objects in the database ... clicking on the “view links” icon , the computer system display a “viewing link” screen as fig. 5a) (see also col. 9, lines 36-53, Listou);

access means for use in interrogating the database and diary system (fig. 5 and col. 10, lines 52-67, Listou);

display means for selectively displaying both the due dates and the primary documents to which said due dates pertain (fig. 4, 6 and corresponding text, Listou).

#### **4. *Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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**5. Claims 2, 4, 6, 9, 10, 12, 16, 18, 20, 23, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Listou (U.S 6216139) in view of Mora et al. (U.S 6161113) (Mora).**

Regarding claims 2 and 16, all the limitations of these claims have been noted in the rejection of claims 1 and 15 above, respectively. However, Listou didn't disclose: wherein each primary document is divided into a series of sections and said electronic link allows access to the section of the primary document to which a particular due date pertains. On the other hand, Mora discloses: wherein each primary document is divided into a series of sections and said electronic link allows access to the section of the primary document to which a particular due date pertains (fig. 3, 4, 6-8 and col. 10, lines 40-45, Mora). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the steps for wherein each primary document is divided into a series of sections and said electronic link allows access to the section of the primary document to which a particular due date pertains in the system of Listou as taught Mora. The motivation being to enable system provided schedule- details of the work breakdown structure for the project (col. 9 lines 50 to col. 10, , lines 44, Mora).

Regarding claims 4 and 18, all the limitations of these claims have been noted in the rejection of claims 1 and 15 above, respectively. In addition, Listou/Mora discloses: wherein said database is divided into sections each section cross referenced to the others (fig. 3, 4, 6-8, Mora), the section including: at least a first section which incorporated summaries of each of the primary documents stored in said database (col. 9, lines 60-64, Mora); a second section which incorporates the primary document themselves (col. 10,

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lines 26-28, Mora), and a third section which incorporates the defined terms in each of the primary documents (col. 11, lines 19-55, Mora).

Regarding claims 6 and 20, all the limitations of these claims have been noted in the rejection of any one claims 1-5 and 15-19 above, respectively. In addition, Listou/Mora discloses: wherein said database is sortable by variety of predefined sort categories (col. 15 lines 7-14, Mora). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the steps wherein said database is sortable by variety of predefined sort categories in the system of Listou as taught Mora. The motivation being to enable system provided the form documents that category and subject and the text, views allow sorting and categorization of these topics (col. 15 lines 7-14, Mora).

Regarding claims 9 and 23, all the limitations of these claims have been noted in the rejection of claims 1 and 15 above, respectively. In addition, Listou/Mora discloses: wherein said information management system is accessible to one or more client users on a communication network (col. 2, lines 62 to col. 3, lines 2, Mora).

Regarding claims 10 and 24, all the limitations of these claims have been noted in the rejection of claims 9 and 23 above, respectively. In addition, Listou/Mora discloses: wherein said communication network includes the Internet, intranet, and local area network (col. 3, lines 16-28, Mora).

Regarding claims 12 and 26, all the limitations of these claims have been noted in the rejection of claims 9 and 23 above, respectively. In addition, Listou/Mora discloses: wherein said information management system can be updated, maintained or monitored by said client users over said communication network (col. 17, lines 52-64, Mora).

**6. Claims 3, 5, 7, 8, 11, 13, 14, 17, 19, 21, 22, 25 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Listou (U.S 6216139) in view of Tarter et al. (U.S 5704044) (Tarter).**

Regarding claims 3 and 17, all the limitations of these claims have been noted in the rejection of claims 1 and 15 above. However, Listou didn't disclose: wherein said system and method includes a cross referencing facility which allows details of one or more primary documents to be linked to details of related primary documents such that when a user actions a due date and/or obligation associated with one or more primary documents, said user is alerted of due dates and/or obligations to be action related documents. On the other hand, Tarter discloses: wherein said system and method includes a cross referencing facility which allows details of one or more primary documents to be linked to details of related primary documents such that when a user actions a due date and/or obligation associated with one or more primary documents, said user is alerted of due dates and/or obligations to be action on related documents (col. 43, lines 31-57, Tarter). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include includes a cross referencing facility which allows details of one or more primary documents to be linked to details of related primary documents such that when a user actions a due date and/or obligation associated with one or more primary documents, said user is alerted of due dates and/or obligations to be action on related documents in the system of Listou as taught Tarter. The motivation being to enable system notifies to the payors (user) the amount and date due for the just closed cycle, a payor invoice for an invoice (col. 43, lines 31-57, Tarter).



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Regarding claims 5 and 19, all the limitations of these claims have been noted in the rejection of claims 1 and 15 above, respectively. In addition, Listou/Tarter discloses: a fourth section of related documents in the form of advices, correspondence, annexes, contact details, or standard clauses, which relate to primary documents (col. 26, lines 56 to col. 27, lines 19, Tarter).

Regarding claims 7 and 21, all the limitations of these claims have been noted in the rejection of claims 1 and 15 above, respectively. In addition, Listou/Tarter discloses: wherein said electronic diary system records all due dates which arise out of the documents on which an action must be taken (col. 43, lines 64 to col. 44, lines 5, Tarter).

Regarding claims 8 and 22, all the limitations of these claims have been noted in the rejection of claims 1 and 15 above, respectively. In addition, Listou/Tarter discloses: wherein said electronic diary system contains a means of notifying appropriate individuals prior to and/or on each due date (col. 42, lines 63 to col. 43, lines 10, Tarter).

Regarding claims 11 and 25, all the limitations of these claims have been noted in the rejection of claims 9 and 23 above, respectively. In addition, Listou/Tarter discloses: wherein reminders generated by said information management system are forwarded via said communication network to individuals who take responsibility for carrying out the tasks to which the due dates relate (col. 43, lines 30-46, Tarter).

Regarding claims 13 and 27, all the limitations of these claims have been noted in the rejection of any claims 1-12 and 15-26 above, respectively. In addition, Listou/Tarter discloses: wherein said documents have a multiplicity of rights and/or obligations including due dates internal to said documents and distributed in different clauses spread throughout said documents (col. 32, lines 14-37, Tarter).

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Regarding claims 14 and 28, all the limitations of these claims have been noted in the rejection of claims 1 and 15 above, respectively. In addition, Listou/Tarter discloses: wherein said documents have a multiplicity of rights and/or obligations including due dates external to said documents and distributed in different clauses spread throughout said documents (col. 43, lines 30-46, Tarter).


As per claims 29 and 30, all the limitations of these claims have been noted in the rejection of claims 1-28. It is therefore rejected as set forth above.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 703-305-4698. The examiner can normally be reached on M-F: 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

  
Cindy Nguyen  
August 22, 2004

  
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